

ATTORNEY DOCKET NO. 03269.0109U1
Application No. 10/627,945

discussion. If not, it is respectfully requested that the Examiner notify the undersigned of the requirement to submit an Applicant's Interview Summary.

A. Acknowledgement of Restriction Requirement and Election

Applicant confirms the provisional election made with traverse to prosecute the invention of Group 1, Claims 45-53. Applicant further acknowledges that Claims 54-67 have been withdrawn from further consideration as being drawn to a non-elected invention.

B. Claim rejections under 35 U.S.C. § 102

The Office Action has rejected claims 45-47 under 35 U.S.C. § 102(b) as allegedly being anticipated by Gamblin, U.S. Patent No. 4,842,646 ("Gamblin"). In particular, it is alleged in the Office Action that Gamblin discloses a textile dye with the following preferred embodiment of an aqueous ink or dye bath comprising:

- a) about 0.0001 to about 15 parts by weight of a water insoluble nigrosine dye, induline dye or basic dye; b) about 0.0001 to about 60 parts by weight of a hydroxycarboxylic acid having at least three hydroxyl groups; c) about 0.0001 to about 60 parts by weight of a water miscible solvent; d) about 25 to about 100 parts by weight of water; and optionally, e) about 0.0001 to about 30 parts by weight of a mordant (e.g., tannic acid or gallic acid, preferably tannic acid). (col. 3, lines 50-68).

The Office Action thereby alleges that Gamblin anticipates the present invention as a result of this disclosure.

The Office Action further alleges that claims 45-50 and 52 are anticipated under 35 U.S.C. § 102(b) by DeLathauwer *et al.*, U.S. Patent No. 5,738,688 ("DeLathauwer"). While the Office Action sets forth a detailed description of the basis of the anticipation rejection, the basis of the rejection is that DeLathauwer *et al.* discloses the use of tannic acid in acidic medium for treatment of textile fibers.

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The anticipation rejections in view of Gamblin and DeLathauwer can be addressed together. Neither of these references discloses a tannic acid having less than about 3% parts by weight gallic acid. Indeed, Gamblin uses tannic acid *or* gallic acid, which indicates that Gamblin does not recognize that gallic acid can be in tannic acid in any amount. (*See e.g.*, col. 3, line 5.) Further, DeLathauwer states that "any commercial tannic acid can be used, though it is economical to use a tannic acid with relatively high molecular weight." (Cols. 2-3, lines 65-1.) From these disclosures, it is apparent that neither Gamblin nor DeLathauwer recognizes any gallic acid content in the tannic acids disclosed therein.

Applicant contends that any general disclosure of tannic acid that may be identified in a prior art reference will not anticipate the presently claimed tannic acid having the recited amount of gallic acid. In this regard, the Examiner's attention is directed toward M.P.E.P. 2131.02 wherein *Akzo N.V. v. International Trade Comm*, 808 F.2d 1471 (Fed. Cir. 1986) is cited. In that case, the Federal Circuit held that a prior art disclosure of sulfuric acid did not anticipate a claim reciting 98% sulfuric acid. *Akzo* is analogous to the present situation in that neither Gamblin nor DeLathauwer teach or suggest the recited amount of gallic acid in the tannic acid. A copy of this case is included for the Examiner's convenience.

To the extent that it will be contended that the claimed gallic acid content is inherent in Gamblin and/or DeLathauwer, Applicant contends that no prima facie case of inherency can be made out from these references.

To establish inherency, it must be clear that the missing descriptive matter (that is, at least the recited gallic acid content of tannic acid) is *necessarily present* in the thing described in the prior art reference. The mere fact that a certain thing may result from a given set of

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circumstances is insufficient to prove anticipation. *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Indeed, inherency is not established by possibilities or probabilities. *Standard Oil Co. (Indiana) v. Montedison, S.p.A.*, 664 F.2d 356, 372 (3d Cir. 1981). Thus, to establish that the reference inherently anticipates the claimed invention, the Office Action must show that the general teaching of "tannic acid" in the reference must mean tannic acid with less than 3% gallic acid, without question and without variability. This has not been shown in the Office Action. Because the recited gallic acid content does not necessarily follow from bare disclosure of tannic acid in the Gamblin and DeLathauwer references, the claimed invention is not inherently anticipated by these references.

Rejections under 35 U.S.C. § 103(b)

Claims 51 and 53 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the DeLathauwer reference for the reasons set forth in the anticipation rejection. In particular, the Office Action states:

The reference does teach that a solution is formed and that methacrylic polymer are used, therefore there would be a reasonable expectation of success to modify the prior art to arrive at the instantly claimed invention because the prior art suggest a solution which by definition contains no solids and a polymer that is known to be mixed with a fluorochemical in the required amounts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the instant composition in view of the reference.

Applicant respectfully requests clarification of the above grounds of rejection because it is not understood what aspects of DeLathauwer are being used to reject the claimed invention on obviousness grounds.

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In any event, as detailed above, DeLathauwer does not mention or suggest in any way the claimed gallic acid content of the tannic acid therein. Therefore, it is respectfully submitted that DeLathauwer does not render the present invention obvious for at least the reasons set forth above.

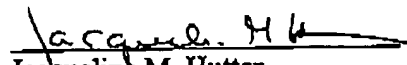
CONCLUSION

It is believed that the claims are in condition for allowance and Applicant respectfully seeks notification of same.

A Credit Card Authorization Form PTO-2038 in the amount of \$120.00 is enclosed to cover the fee for the One (1) Month Extension of Time. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

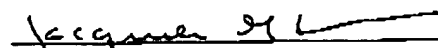
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CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. 4.118

I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via facsimile transmission to: Examiner Hamlin, D., Art Unit 1751, (703) 872-9306 on the date indicated below.


Jacqueline M. Hutter

4/1/05
Date